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Paper No. 6

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OFFICE OF PETITIONS
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In re Application of : SUBSTITUTE
Sunil Tomar et al : DECISION ON PETITION
Application No. 09/660,837 : REFUSING TO ACCORD
Filed: September 14, 2000 : STATUS UNDER 37 CFR 1.47(a)
Attorney Docket No. 005100.P001 : :

SUBSTITUTE DECISION ON PETITION

This is in response to the petition under 37 CFR 1.47(a), filed January 8, 2001. The decision mailed May 23, 2001 is vacated.

The petition is dismissed.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the nonsigning inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Any extensions of time will be governed by 37 CFR 1.136(a).

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the nonsigning inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the nonsigning inventor. Applicant lacks items (1) and (2) set forth above.

As to item (1), the petitioner merely states that he directed his administrative assistant, Deborah L. Higham, to send by Certified Mail and Federal Express to nonsigning inventor Neelamraju an "Inventor Declaration and Power of Attorney

form and an Assignment" on two separate occasions, but the forms were never returned. However, there is no indication that these mailings included a copy of the application papers (specification, claims and drawings). Therefore, unless nonsigning inventor Srinivasarao Neelamraju was presented with a copy of the application papers, Mr. Neelamaraju could not attest that he has "reviewed and understands the application papers" and therefore could not sign the declaration which he was given. Accordingly, Rule 47 applicant has failed to show or provide proof that the nonsigning inventor has refused to sign the declaration. Did inventor Neelamaraju receive the application papers? See Manual of Patent Examining Procedure, Section 409.03(d). While the petition indicates that the inventor declaration and assignment forms were mailed by certified mail and Federal Express, no evidence has been presented that applicant did in fact receive these two mailings. Therefore, unless petitioner can show that a copy of the application papers was presented to inventor Neelamraju, then petitioner will have to mail a copy of the complete application papers (specification, claims and drawings) to inventor Neelamraju's last known address, return receipt requested. A cover letter of instructions should accompany the mailing of the application papers setting a deadline or a statement that no response will constitute a refusal. This sort of ultimatum lends support to a finding of refusal by conduct. The proof of the pertinent events should be made by a statement of someone with firsthand knowledge of the events and should include documentary evidence, such as certified mail return receipt, cover letter of instructions, telegram, etc. See MPEP 409.03(d).

Where there is an express or oral refusal, that fact, along with the time and place of the refusal, must be stated in an affidavit or declaration **by the party to whom the refusal was made**. Where there is a written refusal, a copy of the document(s) evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the rule 47 applicant that an omitted inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence must be submitted.

Whenever an omitted inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

As to item (2) above, a declaration in compliance with 37 CFR 1.63 and 1.64 has not been presented. In this regard, the declaration fails to set forth the citizenship of nonsigning, joint inventor Srinivasarao Neelamraju. Note MPEP 409.03(a); MPEP

602, and MPEP 605.01. Accordingly, a declaration in compliance with 37 CFR 1.63 and 1.64 is required.

In order to expedite consideration, petitioner may wish to submit the renewed petition under 37 CFR 1.47(a) by facsimile transmission to the telephone number indicated below and to the attention of the undersigned.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision should be directed to the undersigned at (703) 305-8680.

Frances Hicks
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